



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,355	05/15/2001	Awele Ndili	24286-711	1773

21971 7590 08/13/2004

WILSON SONSINI GOODRICH & ROSATI  
650 PAGE MILL ROAD  
PALO ALTO, CA 943041050

EXAMINER

REFAI, RAMSEY

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/858,355

Applicant(s)

NDILI ET AL.

Examiner

Ramsey M Refai

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

### **DETAILED ACTION**

1. Claims 1-16 are presented for examination.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Group 1: Claims 1-12 are drawn to a method for having a content engine interact with a mobile device and a method for providing network events to a mobile device, class 709, subclass 217.
  - II. Group 2: Claims 13-16 are drawn to a method for paginating a network event into a wireless format, classified in class 715, subclass 501.1.
3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as in a system lacking a content engine to interact with a mobile device and a method for providing network events to a mobile device, particulars. See MPEP § 806.05(d).
4. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

Art Unit: 2154

(a) the Group I search (claims 1-12) would require use of search **Class 709, subclass 217**.

(b) the Group II search (claims 13-16) would require use of search **Class 715, subclass 515.1**.

5. A telephone call was made to Mr. Peter Eng, the applicant's representative, on July 23, 2004 to address a possibility of restriction requirement. The applicant chose an election of Group I, which is, claims 1-12, without traverse.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Claims 13-16 are withdrawn from examination.

8. Claims 1-12 are now presented for examination.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter (U.S. Patent Publication No. US 2001/0047426).

11. As per claim 1, Hunter teaches a method for having a content engine interact with a mobile device, the method comprising:

having the content engine receive a wireless communication from the mobile device that includes a card representing a URL and an identifier of the mobile device (abstract and paragraph [0012 and 0022]; the linkage code has similar functions as a card) ;

having the content engine signal a database management system for an identification for the card to retrieve instructions for assembling the content available on the URL for the mobile device (paragraph [0024 and 0030]);

having the content engine access a network site located by the URL to retrieve specific network events which are identified from the instructions received from the database management system (paragraph [0024 and 0030]);

Art Unit: 2154

having the content engine convert the network event into a wireless format for the mobile device (paragraph [0010, 0028, and 0036]); and

transmitting the network event in a wireless protocol to the mobile device (paragraph [0028]).

12. As per claim 2, Hunter teaches a method wherein the content engine signals the database management system over a network (paragraph [0024])

13. As per claim 3, Hunter teaches a method wherein the selected instructions are based on the identification of the card provided to the database management system (paragraph [0030-0031]).

14. As per claim 4, Hunter teaches a method wherein the instructions are configured for the URL based on the card identification (paragraph [0010 and 0012]).

15. As per claim 5, Hunter teaches a method wherein the content engine reformats the network event or content into a wireless format (paragraph [0010 and 0028]).

16. As per claim 6, Hunter teaches a method wherein the network event or content is formatted for a display of the mobile device(paragraph [0010]).

17. As per claim 7, it contains similar limitations as claim 1, therefore is rejected under the same rationale.

18. As per claim 8, Hunter teaches a method wherein the user-defined parameters are provided by a user of the mobile device (paragraph [0024]).

19. As per claim 9, Hunter teaches a method wherein the user-defined parameters affect how the content engine selects and accesses the network event for the mobile device (paragraph [0030]).

20. As per claim 10, Hunter teaches a method wherein the user-defined parameters affect how the content engine delivers the network event to the mobile device (paragraph [0010]).

21. As per claim 11, Hunter teaches a method wherein the user-defined parameters are stored in a user database and maintained in accounts (paragraph [0024]).

22. As per claim 12, Hunter teaches a method wherein the accounts are configurable to include preferred parameters (paragraph [0024]).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Browning (U.S. Patent No. 6,707,581)
- b. La Fluer (U.S. Patent No. 6,708,214)

Art Unit: 2154


c. Kavensky (U.S. Patent No. 6,300,947)

d. Knowles (U.S. Patent No. 6,622,917).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey M Refai whose telephone number is (703) 605-4361. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Ramsey M Refai  
Examiner  
Art Unit 2154

RMR  
July 23, 2004